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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL F. WILLIAMS, DAVID ALLISON BENNETT,
LYNN SHAINDELL GOLDBABER, DENNIS GLAVIN, LORY ELIZABETH
LORY KRETT, CHARLES D. MENTZER, STEPHEN M. TEGLOVIC,
JOHN M. DIETZ, WILLIAM W. SMITH, III, PAUL BILIBIN, JINYUE LIU,
PAUL R. MCLAUGHLIN, SCOTT MEYER, and SEAN HU

Appeal 2008-001302
Application 09/820,377
Technology Center 3600

Decided:¹ May 29, 2009

Before, MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 7, 10-14, 23-26. Claims 1-6, 8, 9, and 15-22 are withdrawn from consideration. We have jurisdiction under 35 U.S.C. § 6(b). (2002)

SUMMARY OF DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellants claim a system and method for using computer systems for shipping management, and specifically online computer systems for enterprise parcel shipping management. (Specification 1:5-6)

Claims 7 and 10, reproduced below, are representative of the subject matter on appeal.

7. An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to:
receive a request by a first user within an enterprise to ship a parcel, wherein the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels, wherein the request comprises a set of partial shipment information, and wherein the set of partial shipment information comprises at least one of: a destination name, a destination address, a return name, a return address, or package information;

in response to the request by the first user to ship the parcel: (A) generate a printable bar-coded pre-processing traveler label, wherein the printable bar-coded pre-processing traveler label comprises at least a machine-readable code that corresponds to the request, (B) save in the memory accessible by the computer system, a relationship between the machine-readable code and the set of partial

shipment information, and (C) print the printable bar-coded pre-processing traveler label, wherein said printed printable bar-coded pre-processing traveler label comprises an expression of the machine-readable code;

receive an input for finalizing a shipping label for shipping the parcel from a second user within the enterprise, wherein the second user is designated in the memory accessible by the computer system as authorized to finalize shipping labels, wherein said input comprises the machine-readable code;

retrieve from the memory the set of partial shipment information according to the machine-readable code; and

generate a shipping label comprising at least a first item of information from the set of partial shipment information and according to the input from the second user.

10. (Previously Presented) An online, Internet-based, multi-carrier, multi-parcel shipping management computer system, said computer system programmed to: according to a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system, a first set of shipping privilege settings identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests;

according to a second set of instructions input by the administrator, designate in the memory, a second set of shipping privilege settings identifying at least a second user within the enterprise as authorized to print shipping labels according to a pre-processing shipping request by any user of the plurality of users; and in response to an input by a first user of the plurality of users, display interactive graphic user interface shipping selection options to the first user according to the first set of shipping privilege settings.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Kara	US 6,233,568 B1	May 15, 2001
Gendreau	US 2001/0034608 A1	Oct. 25, 2001

Stefik

US 2003/0115144 A1

Jun. 19, 2003

The following rejections are before us for review.

The Examiner rejected claim 7 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner rejected claims 7, 10-14, and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over Gendreau in view of Stefik.

The Examiner rejected claims 10-14 under 35 U.S.C. § 103(a) as being unpatentable over Gendreau in view of Stefik, and further in view of Kara.

ISSUES

Have Appellants shown that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention in that the claimed term “finalize” is a broadened version of the disclosed step of printing the shipping labels?

Have Appellants shown that the Examiner erred in rejecting claims 7, 10-14, and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over Gendreau in view

of Stefik on the ground that a person with ordinary skill in the art would understand that the act of printing data onto a shipping label is itself a form of copying, namely the data which resides in the buffer of the printer is copied onto the label substrate in human-readable form and that usage rights disclosed by Stefik are a restriction on who can copy a given data set?

Have Appellants shown that the Examiner erred in rejecting claims 10-14 under 35 U.S.C. § 103(a) as being unpatentable over Gendreau in view of Stefik, and further in view of Kara on the ground that a person with ordinary skill in the art would understand that Stefik discloses designating a first set of shipping privilege settings identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests when it discloses content based access levels such as “next set of rights” which cover how a work is used down stream of the initial copy?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Examiner’s rejection of claim 7 under 35 U.S.C. § 112, First Paragraph is based upon an objection made under 35 U.S.C. § 132(a). (Ans. 4).
2. The objection under 132(a) states:

The amendment filed 1/18/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The

claims have added the following limitations which are not supported by the original specification "the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels" the specification talks about users being able to finalize shipping labels, but not specifically disclose the system designating users as being "restricted from finalizing the shipping labels" does not appear in the specification, therefore the appellant not having support for this phrase in the original disclosure. (Ans. 3).

3. Claim 10 as originally filed recited in part: *designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise.*

4. Gendreau discloses that the scanned information regarding the addressee is inputted into the computer in that it discloses "[a]fter the computer-readable information is inputted into the computer system 18, the box 10 proceeds along the conveying path on the conveyor 12 through a scanning device 24..." (Gendreau, ¶[0033]).

5. Gendreau discloses

[a]s the box 10 continues further down the conveyor 12 along the path, a label 27 is printed by a shipping label printer 28 for the appropriate shipping carrier, which is then attached to the box 10 by the operator 30. The label may be applied by the operator 30 as shown or the process of applying labels may be automated. The printer 28 prints labels 27 that may include tracking numbers, in accordance with the standards of the carriers. The system 18 also sends manifest and invoicing information in accordance with carrier standards. The box 10 may then be directed to the appropriate shipping carrier along the conveying path to the loading dock so

that it may be shipped to its final destination. (Gendreau, ¶[0034]).

6. The Examiner found that Gendreau discloses in response to the request by the first user to ship the parcel: (A) generate a printable bar-coded pre-processing traveler label as invoice 22). (Ans. 5).

7. Gendreau discloses that the invoice has computer-readable information and need not be attached to the parcel but rather "...the invoice 22 may be a printed document that travels with but is not connected to the parcel (i.e., at least associating computer-readable information with the parcel via an associated order request). ((Gendreau, ¶[0032])).

8. The Examiner found that:

Gendreau however, fails to disclose the computer system being capable of assigning printing rights to a user, whether the user is designated as being able to print a shipping label, and finalize a shipping label. Stefik, discloses a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system a setting for a user to be restricted from printing but capable of submitting requests (See Figure 4a and paragraphs 0016, 0040, 0065-0067). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gendreau, to allow for the restricting of printing and finalizing documents, in order to control the use of a digital work.... (Ans. 5).

9. Stefik discloses that a user interface is provided and is "...broadly defined as the mechanism by which a user interacts with a repository in order to invoke

transactions to gain access to a digital work, or exercise usage rights.” (Stefik, ¶[0095]).

10. Stefik further discloses that

At a minimum, the user interface must permit a user to input information such as access requests and alpha numeric data and provide feedback as to transaction status. The user interface will then cause the repository to initiate the suitable transactions to service the request. Other facets of a particular user interface will depend on the functionality that a repository will provide. (Stefik, ¶[0097]).

11. Stefik discloses that copying of a work is controlled by usage rights attached to that work. (Stefik, ¶[0041]).

12. Stefik discloses content based access levels, such as “next set of rights”, which are attached to the work as it is transported and control the digital work to prohibit any further rights to loan out the copy (Stefik, [¶[0065-0067])).

PRINCIPLES OF LAW

The factual inquiry for determining whether a specification provides sufficient written description for the claimed invention is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams,

and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

ANALYSIS

The rejections are affirmed as to claims 7, 23-26, and reversed as to claims 10-14. The Appellants do not provide a substantive argument as to the separate patentability of claims 23-26 that depend from claim 7, which is the sole independent claim among those claims. Therefore, regarding the claims whose rejection is affirmed, we address only claim 7. Claims 23-26 fall with claim 7. *See*, 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Claim 7 rejected under 35 U.S.C. § 112, first paragraph.

In rejecting claim 7 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, the Examiner reasons that the "...claims have added the following limitations which are not supported by the original specification 'the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels'...." (FF 1,2).

We disagree with the Examiner that an amendment to the claims is new matter. "Broadening a claim does not add new matter to the disclosure. Disclosure is that which is taught, not that which is claimed. An applicant is entitled to claims as broad as the prior art and his disclosure will allow. *In re Rasmussen*, 650 F.2d 1212, at 1214 (CCPA, 1981).

In addition, we find that the claims as originally filed recited *designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise*. (FF3) Thus, clear basis exists for restricting a user from printing shipping labels as claimed here. Appellants further cite to numerous instances in the Specification asserting that the Specification supports finalizing shipping labels being covered by the printing of shipping labels. (App. Br. 22-25). We agree with Appellants. Among these is the description that is cited to at ¶00447 wherein the Specification equates failure to print shipping labels as a non-finalized condition. Thus, the amendment did not broaden the scope of the invention beyond that which is supported in the initial disclosure. See *Schering Corp. v. Amgen*, 222 F.3d 1347, 1352-53 (Fed.Cir.2000).

Accordingly, we will not sustain the rejection of claim 7 under 35 U.S.C. 112, First Paragraph.

Claims 7, 10-14, and 23-26 rejected under 35 U.S.C. 103(a) over Gendreau in view of Stefik.

Appellants argue that

Claim 7 is directed to indicating for a particular user, whether or not the user is restricted from taking a particular action, namely, "finalizing shipping labels." As compared to attaching a Stefik usage right to a particular pre-existing digital work, such as, for example, a Stefik "...right to make [a copy]..." of the digital work, Claim 7 is directed to "...generat[ing] a printable bar-coded pre-processing traveler label ..." for a user that is "restricted from finalizing shipping labels." (App. Br. 31).

We disagree with Appellants. The act of printing data onto a shipping label is itself a form of copying, namely, the data which resides in the buffer of a printer is copied onto the label substrate in human-readable form as part of the printing process. Additionally, we find that Stefik generally discloses a restriction on who can copy as controlled by usage rights (FF 11) similarly to how Appellants' second user is designated as authorized to finalize shipping labels. Appellants however argue because in Stefik, a "...usage right is directly related to the existing digital work to which it is attached...", Stefik is incongruent with the claimed second user's authorization to copy (Appeal Br. 31). We disagree with Appellants because Appellants' arguments are not based on limitations appearing in the claims and are not commensurate with the broader scope of claim 7 which merely recites

wherein the second user is designated in the memory accessible by the computer system as authorized to finalize shipping labels, and not designated to finalize only a given label as argued. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Appellants further argue that Gendreau

as compared to the subject matter of Claim 7 wherein the machine readable code is generated and saved by the claimed system, the information in Gendreau pre-exists, e.g., was created as the box is manufactured or when an order is packaged in the box (see, e.g., Gendreau, paragraph 0032) and must be "input" into the Gendreau system. (App. Br. 37).

First, we disagree with Appellants' assessment of the disclosure in Gendreau. While one embodiment in Gendreau discloses creating the machine readable code indicia as the box is manufactured, another embodiment however discloses that the invoice which includes a separate printable bar-coded pre-processing traveler label or invoice 22, which bar-code is machine-readable code that corresponds to the request (FF 7).

Appellants next argue that Gendreau fails to disclose the limitation "save in the memory accessible by the computer system, a relationship between the machine-readable code and the set of partial shipment information...". (Appeal Br. 37). We disagree with Appellants. As found supra (FF 7), Gendreau explicitly discloses that the computer-readable information on the invoice 22 is associated with the parcel via an associated order request. Further, Gendreau discloses that the computer-readable information is inputted into the computer system 18 (FF 4). We infer that a computer system which receives the machine readable code and

which maintains a relationship between the code and the shipment information would somehow save this information either in a database or in a printer buffer as the label is printed. *See KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (In making the obviousness determination one “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ”).

Appellants next argue that claim 10 requires privilege settings by users as set forth by the claim language: *designate in a memory accessible by the computer system, a first set of shipping privilege settings identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests*. The Examiner maintains that Stefik discloses this feature at ¶¶ 0016, 0040, 0065-0067. (Answer 6) However, the access levels discussed in these paragraphs of Stefik are content based access levels such as “next set of rights” which are attached to the work as it is transported and control the digital work to prohibit any further rights to loan out the copy (FF 12). Thus, these rights do not control who gets access to a given piece of data, let alone identifying users who are restricted from copying and authorizing users to submit pre-processing work not involving copying. Accordingly, we cannot agree with the Examiner that Stefik discloses these features, and thus we are persuaded of error as to the rejection of claim 10. Since claims 11-14 depend from claim 10, and since we cannot sustain the rejection of claim 10, the rejection of claims 11-14 likewise cannot be sustained.

Claims 10-14 rejected under 35 U.S.C. § 103(a) over Gendreau in view of Stefik and Kara.

For the above reasons we find that Gendreau and Stefik fail to disclose the feature of *designate in a memory accessible by the computer system, a first set of shipping privilege settings identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests*. The addition of Kara to the combination fails to cure the deficiency of the rejection of claim 10 based on Gendreau and Stefik. Thus we cannot not sustain the rejection of claim 10 based on Gendreau in view of Stefik and Kara. Since claims 11-14 depend from claim 10, and since we cannot sustain the rejection of claim 10, the rejection of claims 11-14 likewise cannot be sustained.

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in claims 7 and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over Gendreau in view of Stefik; Appellants have shown that the Examiner erred in claims 10-14 under 35 U.S.C. § 103(a) as being unpatentable over Gendreau in view of Stefik; Appellants have shown that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 112, first paragraph, and claims 10-14 under 35 U.S.C. § 103(a) as being unpatentable over Gendreau in view of Stefik, and further in view of Kara.

DECISION

The decision of the Examiner to reject claims 7, 23-26, is AFFIRMED and to reject claims 10-14 is REVERSED.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

~~AFFIRMED-IN-PART~~

JRG

KHORSANDI PATENT LAW GROUP, A.L.C.
140 S. LAKE., SUITE 312
PASADENA, CA 91101-4710